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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,735	11/17/2005	Louis Placek	007180-74 US	3966
36234 7590 04/01/2009 THE MCCALLUM LAW FIRM, P. C. 685 BRIGGS STREET PO BOX 929 ERIE, CO 80516				
EXAMINER				
PROUTY, REBECCA E				
ART UNIT		PAPER NUMBER		
1652				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/536,735

Applicant(s)

PTACEK ET AL.

Examiner

Rebecca E. Prouty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Claims 2-9 are canceled in the current response.

Applicants current response also states that claims 10-30 were previously cancelled however, no such cancellation can be found. Claims 10-30 were previously withdrawn from examination as drawn to a non-elected invention but as applicants current amendment states that these claims are cancelled and includes no text for these claims, they are taken as being cancelled herein also. Thus claims 2-30 are cancelled and Claim 1 is still at issue and present for examination.

Applicants' arguments filed on 12/2/08, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is confusing in the recitation of "the RNA transcribed from the polynucleotide of SEQ ID NO:5 wherein the polynucleotide is selected from the group consisting of ..." as the group which follows does not comprise things which would be RNAs transcribed from the polynucleotide of SEQ ID NO:5. The

only polynucleotide which would be produced by transcription of SEQ ID NO:5 would be an RNA which is identical to SEQ ID NO:5 except for the replacement of all thymidine (T) residues with uridine (U) residues. One could not produce a degenerate variant of SEQ ID NO:5 (i.e., a different nucleic acid sequence that still encodes SEQ ID NO:7) as recited by (a), a portion of a degenerate variant by transcription of SEQ ID NO:5 as recited by (b), a complement of SEQ ID NO:5 or a degenerate variant thereof as recited by (c), or a portion of any of these as recited in (d) by transcription of SEQ ID NO:5. For purposes of further examination the claims is interpreted as if it recited:

An isolated ribonucleic acid molecule (RNA) comprising a RNA transcribed from a polynucleotide wherein said polynucleotide is selected from the group consisting of (a) a polynucleotide encoding for the polypeptide consisting of the amino acid sequence of SEQ ID NO: 7; (b) a polynucleotide encoding for a polypeptide consisting of part but not all of the amino acid sequence of SEQ ID NO: 7; (c) a polynucleotide complementary to the polynucleotide of (a) or (b); and (d) a polynucleotide consisting of at least 15 contiguous nucleotides from the polynucleotide of (a), (b), or (c) including the nucleotide corresponding to nucleotide 446 in SEQ ID NO: 5.

Claim 1 is confusing in the recitation "a polynucleotide complementary to the polynucleotide of (a) or (b)" as it is unclear if the recited complementary polynucleotides must be the full length complements or may include fragments also. As part (d) of the claim clearly intends to recite fragments it is

assumed for further examination that applicants intended this portion of the claim to recite full length complements only. If applicants intended the recited complementary polynucleotides to be the full length complements, it is suggested that the claim be amended to recite "a polynucleotide complementary to the full length of the polynucleotide of (a) or (b)".

Claim 1 is confusing in the use of both open (i.e., comprising) and closed (i.e., consisting of) language within the claim making it confusing as to whether the recited RNA can include additional sequence or not. For purposes of further examination the claim is presumed to allow the inclusion of additional sequences.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid consisting of a fragment of at least 15 nucleotides of SEQ ID NO:5 including nucleotide 446, does not reasonably provide enablement for any nucleic acid comprising a fragment of at least 15 nucleotides of a nucleic acid encoding SEQ ID NO:7 including the nucleotide corresponding to nucleotide 446 of SEQ ID NO:5. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope

with these claims. The rejection is explained in the previous Office Action.

Applicants indicate that they amended Claim 1 to incorporate claim 4 (previously indicated as allowable) therein. However, while this may have been applicants intent, the amendment made does not in fact limit claim 1 to the subject matter of previous claim 4 and the amended claim still appears (see 112, 2nd rejections above) to include subject matter not commensurate in scope with the enabled invention. If applicants intend to limit the case to the subject matter of previous claim 4, the following claim is suggested:

"An isolated nucleic acid comprising SEQ ID NO:5."

This claim would be allowable. Furthermore the following slightly broader claim would also be allowable:

"An isolated nucleic acid encoding the polypeptide of SEQ ID NO:7."

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Schmetterer. The rejection is explained in the previous Office Action.

Applicants indicate that they amended Claim 1 to incorporate claim 4 (previously indicated as allowable) therein. However, while this may have been applicants intent, the amendment made does not in fact limit claim 1 to the subject matter of previous claim 4 and the amended claim still appears (see 112, 2nd rejections above) to include subject matter disclosed by Schmetterer. See the suggested claims above for limitations which would overcome the instant rejection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca E. Prouty whose telephone number is 571-272-0937. The examiner can normally be reached on Tuesday-Friday from 8 AM to 5 PM. The examiner can also be reached on alternate Mondays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nashaat Nashed, can be reached at (571) 272-0934. The fax phone number for this Group is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rebecca Prouty/
Primary Examiner
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